

REMARKS

Claims 1-20 are pending in this application.

Amendment to Specification and Claims

The specification and claim 12 have been amended for editorial purposes only.

The Examiner is requested to indicate that these changes are approved.

Reply to Rejections

Sole Rejection

Claims 1-20 were rejected under 35 USC 103(a) as being unpatentable over Logothetis et al., Peterson et al. '473 or '341 or Burdon et al. This rejection is traversed.

It is understood, from the rejection, that the Examiner has used the four patents cited in the alternative. That is, there is no statement of modifying a base reference with teachings from the other reference. The Patent Office is requested to clarify this point.

In rejecting the claims, the Examiner first states: "the [The] methods of fabricating a package as taught by the prior art are functionally equivalent to that claimed by Applicant." But, the Examiner has offered no explanation of what is "functionally equivalent" in the references to what is claimed. That is, the Examiner has not provided any convincing line of reasoning as to why one skilled in the art reviewing the references would have arrived to the combination. See *Ex parte Clap*, 220 USPQ 972 (BPAI 1985) wherein the Board stated as follows:

The Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the reference...we find no line of reasoning in the answer and we know of none as to why the artisan would have found the modifications urged by the Examiner to have been obvious.

Initially, the rejection of the claims as set forth in the Office Action does not present a convincing line of reasoning.

Also, a determination of equivalents under the doctrine of equivalents is a question of fact. See *Lemelson v. United States*, 752 F.2d 1538, 1550 (Fed. Cir. 1985). The Examiner has offered no facts to support his statement of equivalents.

Additionally, the Examiner asserts that "cavities are formed in some layers. It has not been proven to be critical..." Also, with respect to claim 5, 6-8, 11-13, 14-15, 16-20 have not been shown to be critical.

But, the test for obviousness is not criticality (synergism) but obviousness. See *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338 (CCPA 1984) wherein the Court stated as follows:

"Synergism" or "synergism effect" has no place in evaluating other evidence of non-obviousness.

Directing attention to claim 1, which is the base claim, the features of this claim provide a result which is important. See for example, the description on page 5 and 6 in paragraph 19 of the specification. In rejecting claim 1, the Examiner has pointed to nothing in the references which would establish obviousness.

With respect to claim 5, the Examiner asserts this is not critical. But, this is important and provides a result which must be given consideration. The explanation of the improved result is set forth in paragraph 19 of the specification.

In commenting on claim 6-8, the Office Action asserts that these features are not shown to be critical. For claim 6, note the explanation of the improved result as set forth in paragraph 9 of the specification. For example, claim 8 provides a result of providing a ceramic ring instead of metal. This is important, as set forth for example in the specification, paragraphs 23-26.

With respect to claims 12 and 13, the Examiner asserts that this is not-critical. But forming the cavity by machining provides cavities having smooth and straight sidewalls as explained in part in paragraph 21 of the specification. Also, the steps in claims 11-20 result in the formation of the improved device.

Results must be given significance in arriving at the conclusion of obviousness. See the *Gillette co. v. S.C. Johnson and Son, Inc.*, 16 USPQ 1923 (1990) where the court stated as follows:

An analysis of obviousness of a claimed combination must include consideration of the results achieved by that combination. As we explained in *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543 551 (Fed. Cir. 1985) [cited in the MPEP].

In the rejection of the claims, the Examiner asserts that what is claimed is an “obvious design choice.” But obvious design choice is not viable as explained in *In re Chu*, 37 USPQ2d 1089 wherein the Court stated as follows:

(finding of “obvious design choice” precluded where the claimed structure and the function it performs are different from the prior art).

Also, it is considered that the Office Action fails to meet the test of obviousness as set forth in *In re Warner*, 154 USPQ 173, 178 (CCPA 1967) wherein the Court stated as follows:

A rejection based on section 103 clearly must rest on a factual basis, and these facts must be interpreted without hindsight reconstruction of the invention from the prior art. In making this evaluation, all facts must be considered. The Patent Office has the initial duty of supplying the factual basis for its rejection. It may not, because it may doubt that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis.

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the rejection of the claims under 35 USC 103.

### Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact William L. Gates (Reg. No. 20,848) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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